

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE BEFORE THE
BOARD OF PATENT APPEALS AND INTERFERENCES

Applicants: Frank J. McConnell et al. Attorney Docket No. SACO115537
Application No: 09/658,770 Art Unit: 3686 / Confirmation No.: 4422
Filed: September 11, 2000 Examiner: Natalie Pass
Title: METHOD AND SYSTEM FOR PROVIDING INSURANCE POLICIES VIA
A DISTRIBUTED COMPUTING NETWORK

APPELLANTS' THIRD REPLY BRIEF

February 9, 2009

TO THE COMMISSIONER FOR PATENTS:

Safeco Insurance Company of America (hereinafter "Safeco") has reviewed the Examiner's Answer submitted on December 9, 2008, in response to the Board of Patent Appeals and Interferences' (hereinafter "the Board") remand order mailed October 21, 2008. The Examiner's Answer raised a new ground of rejection under 35 U.S.C. § 101. Claims 1, and 3-7 are said to not be directed to patent-eligible processes. Appellants submit this Third Reply Brief in response to the Examiner's Answer and argue that Claims 1, and 3-7 recite patent-eligible subject matter under 35 U.S.C. § 101 in light of *In re Bilski*. Additionally, as explained in the Appeal Brief, the First Reply Brief, and the Second Reply Brief, the cited and applied references do not teach or suggest the claimed invention. A reversal of the decision of the Examiner and issuance of the patent application is respectfully requested.

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I. STATUS OF CLAIMS

On September 11, 2000, Appellants filed the pending patent application including Claims 1-19. On March 3, 2003, the Examiner mailed a first Office Action rejecting Claims 1-19. On May 28, 2003, Appellants filed an Amendment and Response in which Claims 1, 3-6, 8, 10, 14, and 19 were amended and Claims 2 and 9 were canceled. On August 12, 2003, the Examiner mailed a second Office Action, finally rejecting Claims 1, 3-8, and 10-19. An Appeal followed on November 4, 2003, and an Appeal Brief was filed on March 3, 2004. On May 19, 2004, an Examiner's Answer was issued, and a Supplemental Appeal Brief was filed in response on June 18, 2004. A Request for Continued Examination followed on August 11, 2004, requesting further prosecution to address issues raised in the Examiner's Answer. The Examiner issued another final Office Action on November 1, 2004, finally rejecting Claims 1, 3-8, and 10-19.

This Appeal, including the Appeal Brief filed February 22, 2005, follows from the final Office Action of November 1, 2004. On August 2, 2005, an Examiner's Answer was mailed. On September 29, 2005, Appellants filed a First Reply Brief in response, to which a supplemental Examiner's Answer was mailed on May 23, 2006. On July 19, 2006, Appellants filed a Second Reply Brief that was noted by the Examiner on October 19, 2006. On October 21, 2008, the Board remanded the application to the Examiner to determine if Claims 1, and 3-7 are directed to a patent-eligible process under 35 U.S.C. § 101 in light of *In re Bilski*, 545 F.3d 943 (Fed. Cir. 2008). In response, a third Examiner's Answer was mailed on December 9, 2008, which raises a new ground of rejection by rejecting Claims 1, and 3-7 under 35 U.S.C. § 101 as being directed to non-statutory subject matter.

Appellants entreat the Board to reverse the final rejection of Claims 1, 3-8, and 10-19 from the final Office Action of November 1, 2004, and to reverse the new ground of rejection of

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Claims 1, and 3-7 raised by the Examiner on December 9, 2008. The claims on appeal are set forth in Appendix V.

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II. GROUND S OF REJECTION TO BE REVIEWED ON APPEAL

Although this Third Reply Brief is responsive to the new ground of rejection under 35 U.S.C. § 101 of Claims 1, and 3-7, Appellants incorporate all previous arguments filed in the Appeal Brief of February 22, 2005, the First Reply Brief of September 29, 2005, and the Second Reply Brief of July 19, 2006. Appellants submit that the new ground of rejection under 35 U.S.C. § 101 of Claims 1, and 3-7 is improper in light of *In re Bilski*. The subject matter of Claims 1, and 3-7 is configured to provide an insurance premium quote for an individual via a *distributed computing network*, which is one or more machines. Since various features of Claim 1 use the distributed computing network throughout the recited process, this clarifies the claim in that the recited process is tied to one or more machines that comprise a distributed computing network. If *In re Bilski* were to be read as requiring a patent-eligible process to be tied to a machine, it is respectfully submitted that Claims 1, and 3-7 satisfy that requirement under *In re Bilski*.

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III. ARGUMENT

A. Claims 1, and 3-7 Contain Patent-Eligible Subject Matter, Which Is Directed to a Patent-Eligible Process, Satisfying 35 U.S.C. § 101 Under *In re Bilski*

The question before the Board is whether the method recited in Claims 1, and 3-7 is directed to a patent-eligible process under 35 U.S.C. § 101. As guidance, the Federal Circuit announced a machine-or-transformation test to determine whether a claimed process recites patent-eligible subject matter. *In re Bilski*, 545 F.3d at 954. A claimed process contains patent-eligible subject matter under 35 U.S.C. § 101 if: (1) it is tied to a particular machine or apparatus, or (2) it transforms a particular article into a different state or thing. *Id.* In supplement to the machine-or-transformation test, the court in *In re Bilski* laid out other indicia to consider. For example, the machine or transformation "must impose meaningful limits on the claim's scope to impart patent-eligibility." *Id.* at 961-62.

B. Claims 1, and 3-7 Are Tied to One or More Machines

Independent Claim 1 recites a particular machine used by other features within the body of the claim. "A distributed computing network," as recited in Claim 1, is used "for providing an insurance policy" through the features of the method recited in Claim 1. A "network" is defined in the Microsoft Computer Dictionary as "a group of computers and associated devices that are connected by communications facilities. A network can involve permanent connections, such as cables, or temporary connections made through telephone or other communication links." *Microsoft Computer Dictionary* 308 (Microsoft Press 4th ed. 1999). Additionally, as seen in Figure 2 and as disclosed on page 8 of the specification of the present application, there is an exemplary network. There are routers 26A-26N (i.e., "special purpose computers used to interface one LAN or WAN to another"), communication links and other computers, such as computer 22A, that make up the network described in the specification.

In either the above external definition of "network," or the internal use of the term as discussed within the specification of the above-identified application, the "distributed computing network" recited in Claim 1 comprises one or more machines tied to the underlying process of Claim 1. Since the recited process of Claim 1 is directly tied to a machine, the machine-or-transformation test of *In re Bilski* is satisfied.

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IV. CONCLUSION

This Third Reply Brief argues that the new ground of rejection for Claims 1, and 3-7 under 35 U.S.C. § 101 is improper because the claimed subject matter satisfies the *In re Bilski* machine-or-transformation test. Claims 1, and 3-7 specifically recite that the process is tied to one or more machines, "a distributed computing network," which is used by the features of various claims. Since Claims 1, and 3-7 recite a distributed computing network tied to the claimed process, the claims are drawn to patent-eligible subject matter under the machine-or-transformation test of *In re Bilski*.

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V. CLAIMS APPENDIX

1. A method for providing an insurance policy via a distributed computing network, comprising:

receiving a request for a bindable premium quotation for an insurance policy;

in response to said request, receiving information relating to the insurability of an individual to be insured by said insurance policy and information relating to the coverage to be provided by said insurance policy;

gathering underwriting information from one or more outside information resources based upon the identify of said individual;

determining whether said insurance policy may be underwritten;

in response to determining that said insurance policy may be underwritten, calculating a premium for said insurance policy and providing said premium to a requestor of said premium quotation as a bindable insurance premium quotation;

receiving a request to purchase said insurance policy according to said bindable insurance premium quotation; and

in response to said request, re-intermediating an insurance agent and issuing said insurance policy.

3. The method of Claim 1, wherein issuing said insurance policy comprises transmitting an electronic version of said insurance policy to an individual insured by said insurance policy.

4. The method of Claim 1, wherein re-intermediating an insurance agent comprises:

providing a list of available insurance agents;

receiving the selection of a selected agent from the list of available insurance agents;

assigning said selected insurance agent to said insurance policy;

transmitting information regarding said individual and said insurance policy to said selected insurance agent; and

remitting a commission to said selected insurance agent.

5. The method of Claim 1, wherein re-intermediating an insurance agent comprises:

providing a list of available insurance agents, said available insurance agents identified based upon their geographical proximity to said individual;

receiving the selection of a selected agent from the list of available insurance agents;

assigning said selected insurance agent to said insurance policy;

transmitting information regarding said individual and said insurance policy to said selected insurance agent; and

remitting a commission to said selected insurance agent.

6. The method of Claim 1, wherein re-intermediating an insurance agent comprises:

assigning an insurance agent to said insurance policy based upon the geographical proximity of said insurance agent to said individual;

assigning said assigned insurance agent to said insurance policy;
transmitting information regarding said individual and said insurance policy to said assigned insurance agent; and
remitting a commission to said assigned insurance agent.

7. The method of Claim 6, wherein said assigned insurance agent comprises the geographically closest available insurance agent to said customer.

8. A system for providing an insurance policy via a distributed computing network, comprising:

a server computer maintaining a virtual insurance producer Web site available via said distributed computing network, and wherein said virtual producer Web site is operative to:

receive a request for a bindable premium quotation for an insurance policy;

receive information relating to the insurability of an individual to be insured by said insurance policy and information relating to the coverage to be provided by said insurance policy in response to said request;

gather underwriting information from one or more outside information resources based upon the identify of said individual;

determine whether said insurance policy may be underwritten;

to calculate a premium for said insurance policy and to provide said premium to a requestor of said premium quotation as a bindable insurance premium quotation;

receive a request to purchase said insurance policy according to said bindable insurance premium quotation;

re-intermediate an insurance agent; and

issue said insurance policy.

10. The system of Claim 8, wherein said virtual producer Web site is further operative to:

provide an interactive help system to a requestor of said insurance policy.

11. The system of Claim 10, wherein said interactive help system comprises an interactive chat facility for providing real-time communication between said requestor of said insurance policy and an insurance help-desk representative.

12. The system of Claim 11, wherein said interactive help system further comprises an e-mail facility for receiving an electronic mail message from said requestor of said insurance policy and transmitting said message to an insurance help-desk representative.

13. The system of Claim 12, wherein said interactive help system further comprises a facility for notifying an insurance help-desk representative that said requestor of said insurance policy would like to receive a telephone call providing assistance.

14. The system of Claim 8, wherein issuing said insurance policy comprises transmitting an electronic version of said insurance policy to an individual insured by said insurance policy.

15. The system of Claim 14, wherein re-intermediating an insurance agent comprises:

providing a list of available insurance agents;

receiving the selection of a selected agent from the list of available insurance agents;

assigning said selected insurance agent to said insurance policy;

transmitting information regarding said individual and said insurance policy to said selected insurance agent; and

remitting a commission to said selected insurance agent.

16. The system of Claim 14, wherein re-intermediating an insurance agent comprises:

providing a list of available insurance agents, said available insurance agents identified based upon their geographical proximity to said individual;

receiving the selection of a selected agent from the list of available insurance agents;

assigning said selected insurance agent to said insurance policy;

transmitting information regarding said individual and said insurance policy to said selected insurance agent; and

remitting a commission to said selected insurance agent.

17. The system of Claim 14, wherein re-intermediating an insurance agent comprises:

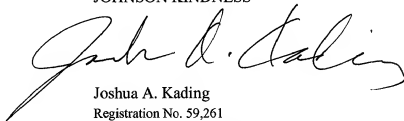
assigning an insurance agent to said insurance policy based upon the geographical proximity of said insurance agent to said individual;

assigning said assigned insurance agent to said insurance policy;
transmitting information regarding said individual and said
insurance policy to said assigned insurance agent; and
remitting a commission to said assigned insurance agent.

18. The system of Claim 17, wherein said assigned insurance agent comprises the geographically closest available insurance agent to said customer.

19. A computer-readable medium containing computer-executable instructions which, when executed by a computer, cause the computer to perform the method of Claims 1, 3, 4, 5, 6, or 7.

Respectfully submitted,
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A handwritten signature in black ink, appearing to read "Joshua A. Kading". The signature is fluid and cursive, with a long horizontal stroke at the end.

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